

REMARKS

Applicants have carefully studied the Office Action mailed on December 18, 2003, which issued in connection with the above-identified application. The present amendments, submissions and remarks are intended to be fully responsive to all points of rejection raised by the Examiner and are believed to place the claims in condition for allowance. Favorable reconsideration and allowance of the present claims are respectfully requested.

Submission of Sequence Listing and Statement pursuant to 37 C.F.R. § 1.821

In the Office Action, the Examiner states that the present application fails to comply with the requirements of 37 C.F.R. §1.821 through 1.825, because no computer readable form or paper copy containing sequence listing has been provided in the instant application.

Applicants respectfully disagree with the rejection and note that the present application was filed on November 28, 2000 together with a copy of Request for Preparation of a Computer Readable Sequence Listing and Statement including paper copy of the sequence listing submitted in the parent application 09/375,514 (copies of all relevant documents including stamped postcard are attached as Exhibit D).

However, to expedite the prosecution, applicants submit with this response a new computer readable form (diskette) and a paper copy containing sequence disclosures found in the above-identified application. Pursuant to Rule 821, Applicants herein state that the contents of the attached paper entitled "SEQUENCE LISTING" and of the accompanying identically labeled diskette, specifically the ASCII-encoded file therein labeled "seqlist.txt", are identical and that the sequence submission contains no new matter. Applicants respectfully submit that the application is now in compliance with the Sequence Listing Requirements pursuant to 37 C.F.R. §1.821 et seq.

Pending Claims

Claims 27-51 are pending and at issue in the application. Claims 27-29, 36, 37, 40, 42, 45, 47, and 50 have been rejected under 35 U.S.C. § 102(b) and as being anticipated by Jansen et al. (Nature Medicine, 4(2): 232-235, 1998). Claims 27-51 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,040,181.

35 U.S.C. §102(b) Rejection

In the Action, claims 27-29, 36, 37, 40, 42, 45, 47, and 50 stand rejected under 35 U.S.C. §102(b) as being anticipated by Jansen et al. (Nature Medicine, 4(2): 232-235, February 1998). In response, applicants note that MPEP Section 706.02 specifies the following rules for determining the effective filing date of an application for the purposes of 35 U.S.C. §102(b) analysis:

- (A) If the application is a continuation or divisional of one or more earlier U.S. applications or international applications and if the requirements of 35 U.S.C. 120 and 365(c), respectively, have been satisfied, the effective filing date is the same as the earliest filing date in the line of continuation or divisional applications.
- (B) If the application is a continuation-in-part of an earlier U.S. application... Any claims which are fully supported under 35 U.S.C. 112 by the earlier parent application have the effective filing date of that earlier parent application.

The present application is a continuation of U.S. application Ser. No. 09/375,514, filed August 17, 1999, which is a continuation of U.S. application Ser. No. 09/080,285, filed May 18, 1998, which is a continuation of U.S. application Ser. No. 08/465,485, filed June 5, 1995, which is a continuation of U.S. application Ser. No. 08/124,256 filed September 20, 1993, which is a continuation-in-part of U.S. application Ser. No. 07/840,716, filed February 21, 1992, which is a continuation-in-part of U.S. application Ser. No. 07/288,692, filed December 22, 1988. In other

Serial No.: 09/724,425
Filed: 11/28/00
Group Art Unit: 1635

words, the instant application is part of a series of continuation applications beginning with U.S. application Ser. No. 08/124,256 filed September 20, 1993, which is in turn part of a series of continuation-in-part applications beginning with U.S. application Ser. No. 07/288,692, filed December 22, 1988. Thus, the same specification has been in this series of applications since September 20, 1993, which is much earlier than February, 1998, the date when the Jensen et al. article was published.

As follows from the papers filed with the application on November 28, 2000 and the attached copy of an amendment to the specification submitted on November 5, 2001 (attached as Exhibit E, see, in particular, page 2 of the amendment) filed in response to the Examiner's request provided in the Office Action dated July 3, 2001 (paper 6, attached as Exhibit F), all requirements of 35 U.S.C. §120 and 37 C.F.R. § 1.78 for applications claiming benefit of earlier filing date and cross-references to other applications have been satisfied. Accordingly, the effective filing date of the present application for the purposes of 35 U.S.C. §102(b) analysis is much earlier than February, 1998, the date when the Jensen et al. article was published. It follows, that the Jensen et al. reference cited by the Examiner does not constitute prior art for the purposes of 35 U.S.C. §102(b).

In light of the above, the rejection of the claims based upon 35 U.S.C. §102(b) is believed to be overcome and withdrawal of such is kindly requested.

Obviousness-type Double Patenting Rejection

In the Action, claims 27-51 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4-7, 9-11, 13, 14, and 19-21 of the commonly owned U.S. Patent No. 6,040,181. In response, a Terminal Disclaimer is attached herein as Exhibit C. This Terminal Disclaimer is being submitted as an expedient and



Serial No.: 09/724,425
Filed: 11/28/00
Group Art Unit: 1635

no admission is hereby made or intended regarding the patentability of the claims of the '181 patent.¹

CONCLUSION

Applicants request entry of the foregoing amendments and remarks in the file history of this application. In view of the above amendments and remarks, it is respectfully submitted that claims 27-51 are now in condition for allowance and such action is earnestly solicited. If the Examiner believes that a telephone conversation would help advance the prosecution in this case, the Examiner is respectfully requested to call the undersigned attorney at (212) 527-7770. The Examiner is hereby authorized to charge any additional fees associated with this response to our Deposit Account No. 04-0100.

Respectfully submitted,

S. Peter Ludwig
Reg. No. 25,351
Attorney for Applicant(s)

Dated: March 18, 2004

DARBY & DARBY, P.C.
805 Third Avenue
New York, N.Y. 10022
Phone (212) 527-7700
IEV:

¹ Applicants note that the term of U.S. Patent No. 6,040,181 has been further disclaimed over the term of the commonly owned U.S. Patent No. 5,831,066 (copy of the Terminal Disclaimer is attached as Exhibit G).